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09/991,255	11/16/2001	Ken Johnson	6634.02	3008

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EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

12/10/1999
6332154

Office Action Summary

Application No.

09/991,255

Applicant(s)

JOHNSON, KEN

Examiner

JAGDISH N PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This communication is in response to amendment filed 2/10/03.

Response to Amendment

2. The specification has been amended per request. Claims 7, 10, 14 and 17 have been amended per request.

Response to Arguments

3. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 10 is rejected under 35 U.S.C. 102(a) as being clearly by anticipated by Newswire.

Claim 10: Newswire discloses an automated system for generating a quote for a piece of leased equipment (vehicle), the system comprising:

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A user interface (the vehicle selection and pricing system allows user to add or delete options or change financing terms, see p. 1);

A server adapted to electronically receive terms of a lease from the user interface, store the terms, process the terms and generate reports (see p.1 the vehicle selection and pricing system is Internet based, inherently the web site www.saturn.com is a server which receives the financing terms, the server also stores this information because it allows the user to send the "information" to a local retailer, the server also processes the terms and generates quote in the form of payment terms as it responds to the user's changing the terms of the lease);

A communication path ... (inherent to a web based automated system of www.saturn.com).

6. Claims 14-19 are rejected under 35 U.S.C. 102(b) as being clearly by anticipated by Dykstra et al. (US Pat. 6.029,149).
(Dykstra)

Dykstra discloses an automated system for generating a credit report for a lessee of a piece of leased equipment, the system comprising:

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A user interface (terminals 26 communicating with central processing unit 10);

A server adapted to electronically receive identification information from the user interface, store the information, process the information and generate credit reports (central processing unit 10, refer to detailed description for functionalities claimed in particular loan application database 108);

A communication path ... (col. 3-4 L 57-, refer to data communication link).

Claim 15. an external server for communication between the user interface and the server (Fig. 1 credit bureau computers 38).

Claims 16. a second communication path electronically linking the server to an external data source (Fig. 1 credit bureau link 36).

Claim 17. is analyzed as per claim 14. Note that no patentable weight is accorded to "a quote for leased equipment" because no claim limitation supports this objective. The claim is treated as being directed to generating credit report

Claim 18 and 19 have analyzed as per claims 15 and 16 respectively.

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over PR Newswire (Saturn Takes a Major Steps Forward in On-Line Electronic Commerce), April 30, 1998 (Newswire).

Per claim 1, Newswire discloses an automated method for generating a quote for a piece of leased equipment, (vehicle selection and pricing), the method comprising:

(a) electronically soliciting from a client terms for a lease for a piece of leased equipment ... (Saturn interactive pricing center offers lease terms that fit user's budget p.1, .."a Saturn guest can ..change financing terms and can see ..");

(b) electronically receiving and storing... the terms for the lease (inherent to Saturn interactive pricing center as disclosed which is Internet based implemented via the disclosed web site www.saturn.com, in which case the

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client specified terms for a lease of a vehicle are received at a web server);

(c) computing payment terms based for the lease based on the terms of the lease and a desired rate for the lease ("Saturn guest" can see payment terms in response to selected changes in payment terms and can adjust lease terms to fit their budget) and;

(d) generating report at the client showing the payment terms for the lease (Saturn interactive pricing center generates a report showing the payment terms for the lease because the client is able to interact with the Saturn web site to receive lease term information).

The Newswire article which recites an interactive, web-based method for automatically generating a quote for a leased equipment, however, fails to teach that the lease terms solicited include a cost and residual value and down payment information.

Official notice is taken that a cost and residual value and down payment, term for the lease (months or years), down payment and residual value are old and well known parameters. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Newswire so a plurality of terms and conditions are available to a client for selecting a lease

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product because it would allow a client to customize a lease that best meets his financial requirements.

Claim 2: the act of generating documentation for the piece of leased equipment such a user may complete the documentation (p.2 summary of the finances selected, which may be used by a dealer to complete a sale of a vehicle).

Claims 3 and 4 : terms for lease include a capital cost, a residual, a dealer fee, a documentation fee, upfront fees, length of lease in months and type of asset (these are customary items of a lease agreement and are anticipated by the applied references). Claim 4 is similarly analyzed as claim 3.

Claim 5: ..receiving the terms for the lease Over the Internet (inherent in Newswire because the method for generating a quote is implemented over the Internet).

Claims 6: Newswire (or alternatively Dykstra) fails to teach that electronically receiving the information through an interactive telephone response system. However, official notice is taken that conducting business transactions over the interactive telephone response system (such as receiving quotes for merchandise, ordering merchandise, catalogue ordering) is old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to carryout the lease process as disclosed in Newswire reference

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using an interactive telephone response system (as an alternative to the Internet access) because allowing access over the interactive telephone response system would enable clients who do not have access to a networked computer system to access the leasing system via a telephone network such as PBX. This would also thus allow more potential customers access to the lease server.

Claim 13. refer to claim 1 analysis in combination with claim 10 analysis.

9. Claims 7-9, 11,12 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over PR Newswire as applied to claim 1 and further in view of Dykstra.

Claim 7: Refer to claim 1 analysis for limitations (a)-(e). Note that instruction from a client to go forward with the lease is inherent Newswire as being the case when the terms of the lease were acceptable.

Steps (f) through (j) are customary steps for determining credit worthiness for lease or purchase of a property. Newswire fails to disclose these steps. However, in the same field of endeavor, Dykstra teaches an automated method of credit evaluation and loan processing system. Dykstra teaches:

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(f) and (g) electronically soliciting from the lessee... the client basic identification information...individual user of the leased vehicle [col. 4 L 42-47, information pertaining to the potential borrower]; for receiving and storing in the server the client basic identification information, [col. 4 L 42-52, loan application database 108];

(h) scoring the lesee's credit using external credit score checking databases (refer to steps 110-114 of Fig. 2A, also refer to col. 4 last paragraph);

(i) and (j) providing a credit report to the client detailing a credit score for the lessee and generating documentation for the vehicle lease such that the user at the client may complete the documentation (col. 5 L 3-24 credit report is displayed to the point of purchase terminal 26, the decision is sent to the merchant..the borrower can take a copy of the approval to the lender for verification and sign the papers for the loan).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Newswire and Dykstra references for their respective teachings so as to obtain a comprehensive method that would provide to the client payment terms for a customized lease (based on selected lease terms of personal choice) and subsequently apply for credit for

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a selected lease and complete the lease transaction based on the credit report provided to the client.

Claim 8. Refer to claim 5 analysis.

Claim 9. Refer to claim 6 analysis.

Claims 11 Refer to claim 7 analysis. All other limitations have been discussed in claim 10 analysis.

Claim 12 an external server for communication between the user interface and the server.

Refer to analysis regarding external servers in view of Dykstra. It would have been obvious to one of ordinary skill in the art at the time of invention to have communication between the user interface and the server so as to determine credit analysis and/or determine eligibility of the user to complete the lease transaction. All other limitations of claim 12 have been analyzed as in claim 10.

All limitations of claim 20 have been analyzed as per claim 7.

All limitations of claim 21 and 22 have been analyzed as per claims 15 and 16 respectively.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7th Floor, Alexandria VA 22202.



Jagdish N. Patel

(Examiner, AU 3624)

October 18, 2002